



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,193	01/24/2005	Michiei Nakamura	264200US0PCT	1488

22850 7590 03/31/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

GREEN, ANTHONY J

ART UNIT PAPER NUMBER

1755

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/522,193

Applicant(s)

NAKAMURA ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/22/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. The preliminary amendment has been entered. Currently claims 1-14 are pending.

Specification

2. The disclosure is objected to because of the following informalities: Applicant should refrain from using "square bracketing" in General formula (1) as square bracketing is normally reserved to show canceled or disclaimed subject matter. In the event that this application ever goes to Reissue the formulaes would therefore be deleted and therefore there is a possibility of confusion. Preferably applicant should parentheses of some sort so no confusion occurs.

Appropriate correction is required.

Claim Objections

3. Claim 1 is objected to because of the following informalities: As stated in the objection to the specification applicant should remove the square brackets and utilize some type of parentheses. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claims 1-3 and 7-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the a colorant having a specific formula, does

Art Unit: 1755

not reasonably provide enablement for every possible type of colorant known to man.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The lack of specific types of organic pigment, linking group and hydrophilic compound is not enabling as applicant has not shown that every conceivable type of colorant which encompasses the claimed formula is envisioned or utilizable in the instant invention. That is, the formula encompasses colorant not actually envisioned or enabled by the specification. Applicant should limit claim 1 to the types actually described in the instant specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to how the components of the formulae are bonded together. Are they ionically bonded or covalently bonded to each other? Clarification is requested. It is unclear as to what is meant by the phrase "an blocking an effect of said [hydrophilic compound] on said [organic pigment].

In claim 2 the phrase "high-molecular azo" is a relative phrase which renders the claim indefinite. The phrase "high-molecular" is not defined by the claim, the

Art Unit: 1755

specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claims 4 and 5 it is unclear as to what is meant by the phrases “(lower alkyl) ammonium group” and “(lower alkanol) ammonium group”. Also the term “lower” is a relative term.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 and 6-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 2002-275387A.

The reference teaches, in the abstract, an organic pigment and method for producing the same, a recording liquid and cartridge, a recording device and recording method using the organic pigment. The pigment is produced by reacting a crude pigment having an amino group on the surface with an acylating agent such as an acid anhydride so that the amino group may couple with a hydrophilic group through a linkage group.

The instant claims are met by the reference. It is the position of the examiner that the organic pigment produced by the process of the reference meets the instantly claimed pigment of claim 1.

9. Claims 1-3 and 6-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 05-222328.

The reference teaches, in the abstract, a colorant represented by formula I which is used as in a water based ink composition and a method for recording therewith.

The instant claims are met by the reference. It is the position of the examiner that the organic pigment of formula I of the reference meets the instantly claimed pigment of claim 1.

10. Claims 1-2 and 6-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 2002-309118.

The reference teaches, in the abstract, a phthalocyanine colorant represented by formula I which is used as in an ink composition, and an ink jet recording method.

The instant claims are met by the reference. It is the position of the examiner that the organic pigment of formula I of the reference meets the instantly claimed pigment of claim 1.

11. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Endo et al (US Patent No. 5,635,552).

Art Unit: 1755

The reference teaches, in column 1, lines 52+ and in the examples, the formation of a pigment composition comprising a pigment, a pigment dispersant, and a water based resin.

The instant claims are met by the reference. It is the position of the examiner that the organic pigment of formula I of the reference meets the instantly claimed pigment of claim 1 absent evidence showing otherwise.

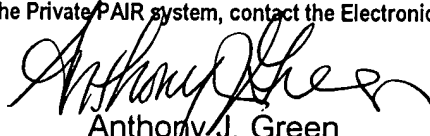
Allowable Subject Matter

12. Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and provided that the 112 rejections are overcome.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
February 06, 2006